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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/803,259

03/18/2004

Ralph B. Lilly

Anon-001:C

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THE MATTHEWS FIRM
2000 BERING DRIVE
SUITE 700
HOUSTON, TX 77057

EXAMINER

NAJARIAN, LENA

ART UNIT

PAPER NUMBER

3626

MAIL DATE

DELIVERY MODE

07/09/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	<p>Application No. 10/803,259</p>	<p>Applicant(s) LILLY ET AL.</p>	
	<p>Examiner LENA NAJARIAN</p>	<p>Art Unit 3626</p>	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 June 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: NONE.
Claim(s) objected to: NONE.
Claim(s) rejected: 1-4, 6-10 and 22-24.
Claim(s) withdrawn from consideration: NONE.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/C Luke Gilligan/
Supervisory Patent Examiner, Art Unit 3626

Continuation of 3. NOTE: The amendment to claim 22 changes the scope of the claim and requires further search and consideration.

Continuation of 11.

Applicant's arguments filed 6/20/08 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 6/20/08.

(1) Applicant argues that the Examiner, on the one hand, has acknowledged that claims 1-4, 6-10 and 22-23 were not amended in the response to the Office Action dated September 26, 2007. On the other hand, the Examiner concludes in paragraph eleven (11) of this current Office Action that the Applicant's Amendment necessitated the new grounds of rejection presented in this Office Action.

As per the first argument, the Examiner respectfully submits that she never indicated that claim 23 was not amended. In fact, the Examiner clearly noted the status of the claims in paragraph 1 of the Office Action mailed February 22, 2008, including the statement that claims 23 and 24 were newly added in the amendment filed December 26, 2007. As such, it is clear that the addition of new claims necessitated the new grounds of rejection presented in the Office Action mailed February 22, 2008. Furthermore, the Examiner indicated in paragraph 9 that Applicant's arguments were fully considered but were not found to be persuasive and Applicant's arguments were addressed. Therefore, the Final Action is not premature and is indeed proper.

(2) Applicant argues that in light of the fact that the Examiner acknowledges that the Cunningham reference and Borsand reference do not teach or suggest the generation of one or more patterns which are indicative of prescription drug abuse, there does not seem to be any support for the concept that the previous amendment filed by the Applicant necessitated the characterization of this previous amendment as necessitating the new grounds of rejection presented in this Office Action.

As per the second argument, the Examiner never made such statements. The Examiner merely presented the reference of Edelson to address newly added claims 23 and 24. In particular, the Examiner addressed the limitation of indicating prescription duplication or multi-source prescription abuse.

(3) Applicant argues that there is no teaching in the references calling for generation of patterns indicative of drug abuse. The present invention is directed to something much greater than merely monitoring the prescription history of the patient.

As per the third argument, the Examiner respectfully submits that she gave the terms "abuse" and "patterns" the broadest reasonable interpretation in light of the Specification. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant's arguments directed towards claim 22 will not be addressed since the amendment has not been entered.